

**REMARKS:**

Claims 1-22 are currently pending in the Application.

Claims 1-22 stand rejected under 35 § U.S.C. 103(a) over Cain et al. (WO 2001/55886 A2, hereinafter referred to as "*Cain*"), in view of Wong et al. (USP 5,890,175, hereinafter referred to as "*Wong*").

The Applicant respectfully submits that all of the Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections. In addition, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

**FINAL REJECTION, PREMATURE:**

The Applicant respectfully submits that the finality of the Office Action mailed 31 October 2007 is premature. For example, the Final Office Action mailed 31 October 2007 consists entirely of material repeated verbatim from the Office Action mailed 18 May 2007. The Applicant respectfully submits that in response to the Office Action mailed 18 May 2007, the Applicant requested various clarifications as to the Examiner's vague and unclear reasoning employed in the Office Action. However, the Examiner remains silent as to the Applicant's requested clarifications of the Examiner's vague and unclear reasoning employed in the Office Action.

For example, the Applicant reminded the Examiner that in an inherency argument the Examiner has the burden of providing "evidence or scientific reasoning to establish the

reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art." (16 August 2007 Response to Office Action, Pages 12-13). However, in the present Office Action, the Examiner remains silent and fails to meet the Examiner's burden of providing any argument, acknowledgement of the Applicant's request, or even an indication that the Examiner reviewed the Applicant's response to the Office Action mailed 18 May 2007, on the issue regarding the Examiner's unsupported belief. On the issue of inherency, the Examiner merely asserts in the present Office Action, which is repeated verbatim from the Office Action mailed 18 May 2007, that "it would be inherent form the prior art that the higher-level (master in relation to the lower level group) can be classified based on a different classification system (classification category) than from secondary group or items in the taxonomy structure." (31 October 2007 Final Office Action, Pages 3-4 and 18 May 2007 Office Action, Page 3). The Applicant respectfully disagrees and respectfully maintains that the Examiner's unsupported statement fails to meet the Examiner's burden of providing evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. In fact, the Examiner's statement that "it would be inherent form the prior art that the higher-level (master in relation to the lower level group) can be classified based on a different classification system (classification category) than from secondary group or items in the taxonomy structure", is merely an unsupported impermissible conclusory statement that fails to provide any evidence, scientific reasoning, or even any reasoning as to the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. In addition, ***the Applicant again respectfully requests that the Examiner provide evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art.***

As another example, the Applicant respectfully requested clarification from the Examiner as to the subject matter for which Official Notice is being taken. (16 August 2007 Response to Office Action, Page 13). Although the Examiner appears to state that no Official Notice has been used in the rejection, (31 October 2007 Final Office Action, Page 2), ***the Applicant again respectfully requests clarification as to the Examiner's***

***statement that “an argument that says a database is not a seller’s database does not hold muster since this is well known in the art” and “Cain itself points out Ebay throughout for making his points clearer and it is well known in the art that Ebay and other similar organizations provide sellers a way to make their own databases which includes different products that the seller is providing to buyers”. (31 October 2007 Final Office Action, Pages 2-3 and 18 May 2007 Office Action, Page 2).***

Therefore, for at least the above reasons, ***the Applicant respectfully requests that the Examiner, at least provide clarifications, as to the Examiner’s vague and unclear reasoning as stated above, and employed in the previous Office Actions, or in the alternative, that the Examiner allow Claims 1-22.***

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 1-22 stand rejected under 35 § U.S.C. 103(a) over *Cain* in view of *Wong*.

The Applicant respectfully submits that the ***amendments to Applicant’s Claims have rendered moot the Examiner’s rejection of these claims and the Examiner’s arguments in support of the rejection of these claims.*** The Applicant further respectfully submits that Applicant’s Claims in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Cain* or *Wong*, either individually or in combination. Thus, the Applicant respectfully traverses the Examiners obvious rejection of Claims 1-22 under 35 U.S.C. § 103(a) over the proposed combination of *Cain* or *Wong*, either individually or in combination.

**The Proposed *Cain-Wong* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant’s Claims**

For example, with respect to amended independent Claim 1, this claim recites:

An ***electronic commerce system for generating, updating, and managing multi-taxonomy environments***, the system comprising:  
one or more sellers’ databases operable to store product data for one or more products;

a **master global content directory coupled with the one or more sellers' databases** including a plurality of product classes organized in a hierarchy according to a **first classification system**, each product class categorizing a plurality of products and associated with one or more attributes of the products categorized in the product class, **at least one of the product classes having one or more associated product pointers that identify one or more of the sellers' databases**;

one or more **secondary content directories coupled with the master global content directory** including one or more product classes organized in a hierarchy according to a **second classification system** that is distinct from the first classification system of the master global content directory, each product class being mapped to one or more product classes in the master global content directory and having one or more associated class pointers that identify the one or more product classes in the master global content directory to which the product class is mapped; and

a search interface operable to:

receive a selection of a product class of a secondary content directory from a user, the selected product class having at least one class pointer identifying at least one product class in the master global content directory; and

communicate, in response to selection of the product class by the user, a search query to one or more of the sellers' databases to search product data stored in the sellers' databases identified by one or more of the product pointers to facilitate a commercial transaction involving one or more products. (Emphasis Added).

In addition, *Cain* or *Wong*, either individually or in combination, fail to disclose each and every limitation of amended independent Claims 8, 15, and 22.

The Applicant respectfully submits that *Cain* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding an “**electronic commerce system for generating, updating, and managing multi-taxonomy environments**” and in particular *Cain* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**master global content directory coupled with the one or more sellers' databases** including a plurality of product classes organized in a hierarchy according to a **first classification system**, each product class categorizing a plurality of products and associated with one or more attributes of the products categorized in the product class, **at least one of the product classes having one or more associated product pointers that identify one or more of the sellers' databases**”. Rather *Cain*

merely discloses that the “**itemdata**” table may comprise more than one database. However, the “**itemdata**” table disclosed in *Cain* is merely an aggregated database of product information. For example, *Cain* discloses a hierarchical product classification system which implements a spider module for searching a network (typically internet websites) for textual information pertaining to products (Figure 4B, page 4, lines 7-12, page 25, lines 12-27), aggregating the product information in a table of a database (page 24, lines 3-5), classifying the aggregated products according to a system taxonomy (page 24, lines 6-29), and optionally generating statistical profiles for association with the products using the information accumulated for the products (page 24, line 30 to page 25, line 8). Ultimately, the database is made available to users on a network such that users can search for products (or otherwise analyze the aggregated product information) and the associated product information and statistical profiles using a variety of search interfaces (page 63, line 13 to page 64, line 5).

Accordingly, *Cain* merely teaches that the aggregated “**itemdata**” maybe stored in more than one database. However, the databases disclosed in *Cain*, that comprises the “**itemdata**” are merely part of the system of *Cain* (i.e., ***the databases are not seller databases, the databases are not coupled with a master global content directory, and the databases are not coupled with one or more secondary content directories***). Thus, *Cain* fails to teach, suggest, or even hint at a “***master global content directory coupled with the one or more sellers’ databases*** including a plurality of product classes organized in a hierarchy according to ***a first classification system***, each product class categorizing a plurality of products and associated with one or more attributes of the products categorized in the product class, ***at least one of the product classes having one or more associated product pointers that identify one or more of the sellers’ databases***” as recited in amended independent Claim 1. The Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Cain* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Cain*.

## **The Office Action Acknowledges that *Cain* Fails to Disclose Various Limitations Recited in Applicant's Claims**

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Cain* fails to disclose various limitations recited in amended independent Claim 1. Specifically the Examiner acknowledges that “*Cain* does not disclose different classification systems”. (31 October 2007 Final Office Action, Page 7 and 18 May 2007 Office Action, Page 2). However, the Examiner asserts that the cited portions of *Wong* disclose the acknowledged shortcomings in *Cain*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Wong*.

The Applicant respectfully submits that *Wong* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding an “**electronic commerce system for generating, updating, and managing multi-taxonomy environments**”. The Applicant further respectfully submits that *Wong* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**master global content directory coupled with the one or more sellers' databases** including a plurality of product classes organized in a hierarchy according to **a first classification system**, each product class categorizing a plurality of products and associated with one or more attributes of the products categorized in the product class, **at least one of the product classes having one or more associated product pointers that identify one or more of the sellers' databases**” and “**one or more secondary content directories coupled with the master global content directory** including one or more product classes organized in a hierarchy according to **a second classification system** that is distinct from the first classification system of the master global content directory, each product class being mapped to one or more product classes in the master global content directory and having one or more associated class pointers that identify the one or more product classes in the master global content directory to which the product class is mapped”.

In particular, the Examiner asserts that “*Wong* et al. discloses different classification systems”. (31 October 2007 Final Office Action, Page 7 and 18 May 2007 Office Action, Page 2). The Applicant respectfully disagrees and respectfully directs the

Examiner's attention to the cited portion of *Wong* that purportedly disclose "different classification systems":

A computerized method for dynamically generating and displaying a catalog including a plurality of items, each item being classified by at least group information and product information is disclosed. ***The method allows a merchant user to generate a catalog by classifying new items by entering into pre-defined fields at least group and product information text for each item***, and by optionally specifying a multimedia object associated with the new item, where each field optionally has an associated link to a linked object. The user selects a display template which defines a pre-designed catalog page layout having generally designated areas for placement of text and multimedia objects relating to an associated item. After the user inputs information regarding an item into the form fields, the field contents are associated with corresponding areas of the selected template. The field contents are then stored as a part of a page of the catalog. Upon receiving a request to display a page, the stored field contents are retrieved and checked as to whether the requested page includes any multimedia objects. If so, the logical framing for each area designated for placement of multimedia objects is adjusted to accommodate all of the multimedia objects. The retrieved field contents, including any associated links to linked objects, of the requested page are then combined with the display template to generate a display page, which is displayed to a consumer.

(Abstract). (Emphasis Added). The above-cited portion of *Wong* fails to teach, suggest, or even hint at the "***first classification system***" and the "***second classification system***", as recited in amended independent Claim 1. For example, the above-cited portion of *Wong* merely discloses a ***method to generate a catalog by classifying new items by entering into pre-defined fields group and product information text for each item***. (Abstract). (Emphasis Added). However, even though "***new items***" may be classified and even though a "***catalog***" may be generated by "***classifying new items***" the "***new items***" may ***only*** be classified by "***entering [text for each item] into pre-defined fields***". In addition, even though there may be more than one item, that is there may be "***new items***", there is ***only one way*** to "***classifying [these] new items***", that is by "***entering [text for each item] into pre-defined fields***".

The Applicant respectfully submits that it is ***simply not clear*** how the above-cited portion of *Wong* teaches, suggests, or even hints at amended independent Claim 1 limitation regarding a “***master global content directory coupled with the one or more sellers’ databases*** including a plurality of product classes organized in a hierarchy according to ***a first classification system***, each product class categorizing a plurality of products and associated with one or more attributes of the products categorized in the product class, ***at least one of the product classes having one or more associated product pointers that identify one or more of the sellers’ databases***” and “***one or more secondary content directories coupled with the master global content directory*** including one or more product classes organized in a hierarchy according to ***a second classification system*** that is distinct from the first classification system of the master global content directory, each product class being mapped to one or more product classes in the master global content directory and having one or more associated class pointers that identify the one or more product classes in the master global content directory to which the product class is mapped”.

As discussed above, the Examiner asserts that “*Wong et al.* discloses different classification systems”. (31 October 2007 Final Office Action, Page 7 and 18 May 2007 Office Action, Page 2). The Applicant respectfully disagrees and respectfully requests clarification from the Examiner. For example, ***the Applicant respectfully requests the Examiner to explain what “different classification systems” the Examiner is referring to.*** The Applicant respectfully submits that it is ***simply not clear*** how the above-cited portion of *Wong* teaches, suggests, or even hints at amended independent Claim 1 limitation regarding “***different classification systems***”, as asserted by the Examiner (i.e., what classification systems in *Wong* is the Examiner referring to and to what extent does the Examiner purport that these purported “***different classification systems***” applies to the subject Application). In contrast, the “***first classification system***” recited in amended independent Claim 1 is associated with a master global content directory and provided for organizing a plurality of product classes in a hierarchy, ***wherein each product class categorizes a plurality of products and associated with one or more attributes of the products categorized in the product class.*** In addition, the “***second classification system***” recited in amended



independent Claim 1 is associated with a second classification system that is distinct from the first classification system of the master global content directory and provided for organizing a plurality of product classes in a hierarchy, ***wherein each product class is mapped to one or more product classes in the master global content directory and having one or more associated class pointers that identify the one or more product classes in the master global content directory to which the product class is mapped.*** Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Wong* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Wong*.

#### **The Proposed *Cain-Wong* Combination is Improper Under MPEP § 706.02(j) For Applicant's Claims**

The Applicant respectfully submits that the rejection of Applicant's claims are improper under 35 U.S.C. § 103(a) over the proposed combination of *Cain* and *Wong*, because, *inter alia*, the Examiner's initial burden of proof has not been satisfied. In addition, the Applicant respectfully traverses the rejection of Applicant's claims because the Examiner has not properly complied with MPEP § 706.02(j).

After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with ***reference to the relevant column*** or page number(s) ***and line number(s) where appropriate,***

(B) the difference or ***differences in the claim over the applied reference(s),***

(C) the ***proposed modification of the applied reference(s)*** necessary to arrive at the claimed subject matter, and

(D) an ***explanation why one of ordinary skill*** in the art at the time the invention was made ***would have been motivated to make the proposed modification.*** (MPEP § 706.02(j)). (Emphasis Added).

The Applicant further respectfully submits that the Examiner has not set forth: (1) the relevant teachings of Wong including any references to the relevant column and line numbers of *Wong*, although the Examiner cites the Abstract of *Wong*, the teaching in the Abstract of *Wong* is insufficient to disclose “different classification systems”, as asserted by the Examiner; (2) asserted any argument or remarks regarding the differences in the Applicants claims over *Wong*; (3) asserted any proposed modifications of *Wong* to arrive at the Applicants claimed invention; or (4) asserted any explanation why one of ordinary skill would have been motivated to make the proposed modifications.

In addition to failing to comply with the above MPEP requirements, the Examiner has also failed to establish a *prima facie* case of obviousness based on the three basic requirements set forth in MPEP § 706.02(j). First, there must be some suggestion or motivation, either in *Cain* or *Wong*, or in the knowledge generally available to one of ordinary skill in the art, to modify *Cain* and *Wong*. Second, there must be a reasonable expectation of success. Finally, *Cain* and *Wong*, either individually or in combination, must teach or suggest all the Applicants claim limitations. ***The teaching or suggestion to make the Cain and Wong combination and the reasonable expectation of success must both be found in Cain or Wong and not based on Applicants disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis Added).

The Applicant still further respectfully submit that the MPEP clearly states that the “initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.” (MPEP § 706.02(j)). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the subject Application, the Examiner has not shown the Applicant’s claimed invention to be expressly or impliedly suggested in the *Cain* or *Wong* reference nor has the Examiner presented a convincing

line of reasoning, let alone any reasoning, why the artisan would have found the Applicants claimed invention to be obvious in view of *Cain* or *Wong*. The Examiner is silent as to any objection or rejection of Claims 6, 7, 9-13, 19, 20, 22-26, 39, 40, and 42-46.

The MPEP further states that “it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” (MPEP § 706.02(j)). Thus, if the Examiner continues to maintain the rejection to Claims 1-22 under 35 U.S.C. § 103(a) based on the proposed combination of *Cain* and *Wong*, the Applicant respectfully requests that the Examiner provide a proper argument in support of the Examiner’s rejection, as necessitated by MPEP § 706.02(j).

**The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious Based on the Examiner’s assertion of Inherency**

The Examiner asserts that “it would be inherent from the prior art that the higher-level group (master in relation to the lower level group can be classified based on a different classification system (classification category) than from secondary group or items in the taxonomy structure”. (31 October 2007 Final Office Action, Pages 3-4 and 18 May 2007 Office Action, Page 3). ***The Applicant*** respectfully disagrees and ***respectfully traverses the Examiner’s assertions regarding the purported inherent features in Cain or Wong.***

The Applicant respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight to reach this conclusion and reconstructive hindsight is improper under 35 U.S.C. § 103. An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. (*In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). With respect to the subject Application, the Examiner acknowledges and the Applicant agrees that the *Cain* does not disclose every limitation of amended independent Claim 1 in the same relationship to one another as set forth in amended independent Claim 1.

To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, ***inherency requires that the asserted proposition necessarily flow from the disclosure.*** (*In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986)). ***It is not enough that a reference could have, should have, or would have been used as the claimed invention.*** “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (*Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789). (Emphasis Added). ***Inherency ... may not be established by probabilities or possibilities.*** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (*Skinner*, at 1789, citing *Oelrich*). (Emphasis Added). Where anticipation is found through inherency, the ***Office’s burden of establishing prima facie anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.”*** (*Skinner* at 1789). (Emphasis Added).

***The Applicant respectfully traverses the Examiner’s assertion of inherency.*** Inter alia, the Examiner’s assertion is ***not supported by scientific reasoning or any type of evidence*** and appears to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. With respect to the subject Application, the Examiner’s statement that “an argument that says a database is not a seller’s database does not hold muster since this is well known in the art” and “*Cain* itself points out Ebay throughout for making his points clearer and it is well known in the art that Ebay and other similar organizations provide sellers a way to make their own databases which includes different products that the seller is providing to buyers”, ***is merely a fact that a certain thing may result from a given set of circumstances and is clearly insufficient.*** (31 October 2007 Final Office Action, Page 7 and 18 May 2007 Office Action, Page 2). (Emphasis Added).

Thus, if the Examiner continues to maintain the rejection of Claims 1-22 based on inherency, the Applicant respectfully requests that the Examiner provide ***evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art.***

**The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Cain-Wong* Combination According to the UPSTO Examination Guidelines**

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Cain* or *Wong*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact**” concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection**” under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject Application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Cain* and *Wong*. The Office Action merely states that “it would have been obvious to modify *Cain et al.* to include different classification systems such as that taught by *Wong et al.*”. (31 October 2007 Final Office Action, Page 7 and 18 May 2007 Office Action, Page 6). The Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the **factual findings necessary to establish obviousness** and is not a sufficient **explanation to support the obviousness rejection** based on the proposed combination of *Cain* and *Wong*.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “**obviousness rejection should include**, either explicitly or implicitly in view of the prior art applied, **an indication of the level of ordinary skill.**” (Notice, 72 Fed. Reg. 57528

(Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.***

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether the Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Cain and Wong and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that "in order to have a computerized method for dynamically generating and displaying a catalog including a plurality of items, each item being classified by at least group information and product information." (31 October 2007 Final Office Action, Page 7 and 18 May 2007 Office Action, Page 6). The Applicant respectfully disagrees and further respectfully requests clarification as to how this statement ***explains why the difference(s) between the proposed combination of Cain and Wong and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that ***"the analysis supporting a rejection under 35 U.S.C. 103***

***should be made explicit.***” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on ***obviousness cannot be sustained by mere conclusory statements***; instead, there ***must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***” (KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Applicant respectfully submits that the ***Office Action fails to provide any articulation, let alone, clear articulation of the reasons why the Applicant’s claimed invention would have been obvious.*** For example, the ***Examiner has not adequately supported the selection and combination of Cain and Wong to render obvious the Applicant claimed invention.*** The Examiner’s unsupported conclusory statements that “it would have been obvious to modify *Cain et al.* to include different classification systems such as that taught by *Wong et al.*” and that “in order to have a computerized method for dynamically generating and displaying a catalog including a plurality of items, each item being classified by at least group information and product information”, ***does not adequately provide clear articulation of the reasons why the Applicant’s claimed invention would have been obvious.*** (31 October 2007 Final Office Action, Page 7 and 18 May 2007 Office Action, Page 6). In addition, the Examiner’s unsupported conclusory



statement fails to meet any of the Guidelines rationales to render obvious the Applicant claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Cain* and *Wong*, ***the Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines.***

### **The Applicant's Claims are Patentable over the Proposed *Cain-Wong* Combination**

The Applicant respectfully submits that amended independent Claims 8, 15, and 22 are also considered patentably distinguishable over the proposed combination of *Cain* or *Wong*, for at least the reasons discussed above in connection with amended independent Claim 1.

Furthermore, with respect to dependent Claims 2-7, 9-14, and 16-21: Claims 2-7 depend from amended independent Claim 1; Claims 9-14 depend from amended independent Claim 8; and Claims 16-21 depend from amended independent Claim 15. As mentioned above, each of amended independent Claims 1, 8, 15, and 22 are considered patentably distinguishable over the proposed combination of *Cain* and *Wong*. Thus, dependent Claims 2-7, 9-14, and 16-21 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons discussed herein, the Applicant respectfully submits that Claims 1-22 are not rendered obvious by the proposed combination of *Cain* and *Wong*. The Applicant further respectfully submits that Claims 1-22 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-22 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-22 be allowed.

**CONCLUSION:**

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$810.00 RCE fee and the \$120.00 One-Month Extension of Time Fee to Deposit Account No. 500777.** Although the Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

11 February 2008  
Date

/Steven J. Laureanti/signed  
Steven J. Laureanti, Registration No. 50,274

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